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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,297	02/24/2004	Ronald J. Morrissey	004522-00027	2079
22910	7590	01/26/2006	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			WONG, EDNA	
			ART UNIT	PAPER NUMBER
			1753	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/785,297

Applicant(s)

MORRISSEY, RONALD J.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-21, 23 and 24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16, 18-21, 23 and 24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

This is in response to the Amendment dated January 12, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The **finality** of the rejection of the last Office Action withdrawn in view of the new grounds of rejection.

### ***Response to Arguments***

#### **Claim Rejections - 35 USC § 112**

I. Claims **1-16 and 18-21** have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection of claims 1-16 and 18-21 under 35 U.S.C. 112, first paragraph, is as applied the Office Actions dated October 13, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Claims 1 and 12 recite "(b) a premade aqueous solution of a conducting electrolyte comprising an effective quantity of a non-precipitating electrolyte salt and the hydantoin compound or a substituted hydantoin compound employed in part (a)".

However, page 4, lines 21-24, recites "Additionally, the silver-hydantoin

complexes of this invention are premanufactured in that form to the plating solution, together with an excess of the hydantoin and nonprecipitating electrolyte salt".

The solution this sentence describes comprises silver-hydantoin complexes, excess hydantoin and a nonprecipitating electrolyte salt.

There are no silver-hydantoin complexes in the premade aqueous solution (b) in claims 1 and 12. Thus, the premade aqueous solution (b) in claims 1 and 12, is still new matter.

II. Claims **1-16 and 18-21** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 1-16 and 18-21 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendment.

#### Claim Rejections - 35 USC § 103

I. Claims **1-6** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893** ('893).

The rejection of claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) is as applied in the Office Actions dated June 23, 2005 and October 13, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

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Applicant states that it is difficult to believe that the claimed silver-hydantoin complex is effectively formed in ANY of the Examples of JP '893.

In response, JP 893 teaches 0.1-50 g/l of silver metals (page 4, [0029]) and 1-200 g/l of at least one kind of hydantoin compound (page 6, [0041] and [0042]).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied*, 469 U.S. 851 (1984). In addition, a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use, see *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Further, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See MPEP § 2141.02, MPEP 2145X.D.1 and MPEP § 2123.

Furthermore, Claims 1 and 12 recite "excess molar ratio". This claim limitation reads on a slight excess in order to ensure completion of the reaction.

II. Claims 7-11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893** ('893) as applied to claims 1-6 above, and further in view of **Soutar et al.** (US Patent No. 5,955,141).

The rejection of claims 7-11 under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) as applied to claims 1-6 above, and further in view of Soutar et al. is as applied in the Office Actions dated June 23, 2005 and October 13, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant state that given that JP '893 alone teaches adjusting the pH using potassium hydroxide, the addition of the Soutar reference is simply not necessary - and is thus not relevant.

In response, the prior art (Soutar) is deemed to be analogous as a secondary reference if it addresses the same problem as does the primary reference. *See In re GPAC Inc.*, 35 USPQ 2d 1117, 1120, 1121 (FC 1995).

However, JP '893, alone, teaches that the mineral salts of a sulfate, nitrate, etc. are used as fusibility compounds (page 4, [0033]). A salt of nitric acid is a nitrate.

**III. Claims 12-16** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893 ('893)**.

The rejection of claims 12-16 under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) is as applied in the Office Actions dated June 23, 2005 and October 13, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**IV.** Claims **18-21** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893** ('893) as applied to claims 12-16 above, and further in view of **Soutar et al.** (US Patent No. 5,955,141).

The rejection of claims 18-21 under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) as applied to claims 12-16 above, and further in view of Soutar et al. is as applied in the Office Actions dated June 23, 2005 and October 13, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

Claims **6 and 11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

#### **Claim 6**

lines 1-2, "the surface-active material" lacks antecedent basis.

#### ***Claim Rejections - 35 USC § 103***

Claims **23 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable

over **JP 11-302893** ('893) as applied to claims 1-6 above.

JP '893 is as applied above and incorporated herein.

JP '893 also teaches wherein the pH is from about 10 to 11 (= pH 10.5) [page 10, [0065]].

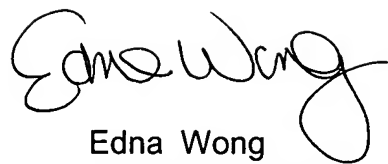
The substituted hydantoin compound is 5,5-dimethylhydantoin (page 2, [0019]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A handwritten signature in black ink, appearing to read "Edna Wong". The signature is fluid and cursive, with the first name "Edna" and last name "Wong" clearly distinguishable.

Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
January 20, 2006